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In re Application of
CHARLES, Mark David *et al*
U.S. Application No.: 09/890,775 : DECISION
PCT No.: PCT/GB00/00345 :
Int. Filing Date: 04 February 2000 : UNDER
Priority Date: 06 February 1999 :
Attorney Docket No.: P/3610-16 : 37 CFR 1.47(a)
For: N²-PHENYLAMIDINE DERIVATIVES :

This decision is in response to applicants' "Petition Under 37 C.F.R. 1.47(a)" ("Pet.") submitted 14 February 2002.

BACKGROUND

On 06 August 2001, applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, a check to pay the required basic fees, an unexecuted declaration, and authorization to charge Deposit Account No. 15-0700 for any additional fees which may be required.

On 17 September 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) must be provided.

On 14 February 2002, applicants submitted a "Response to Notification of Missing Requirements" which was accompanied by, *inter alia*, the instant petition; a three-month extension request and \$920.00 extension fee; the \$130.00 surcharge fee; a declaration signed by five of the seven co-inventors; the \$130.00 petition fee; and a "Declaration of Shona Merigeault in Support of Petition Under 37 C.F.R. 1.47(a)" ("Merigeault Decl.").

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor refuses to execute the application; (3) a statement of the last known address of the missing joint inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

Concerning item (1), the \$130.00 petition fee has been paid.

With regard to item (3), the 37 CFR 1.47(b) applicants state that the last known address of the nonsigning co-inventor, Mark David Charles is:

Flat 18 b,
51-53 Kings Road
Brighton
BN1 1NA
England

Also, the last known address of the nonsigning co-inventor, Donald James Simpson is:

74 Abbots Road
Haverhill
Suffolk CB9 ODH
England

This information satisfies item (3).

Regarding item (4), applicants included a Declaration signed by five of the seven co-inventors. The nonsigning co-inventors' names, residences, post office addresses and citizenship are typed on the declaration. This declaration satisfies the requirements of section 409.03(a) of the Manual of Patent Examining Procedure (MPEP) and is in compliance with 37 CFR 1.497(a) and (b). Thus, item (4) has also been satisfied.

However, applicants have not sufficiently met the requirements of item (2).

Applicants claim that Donald James Simpson "refuses to join in the application." Pet. ¶ 2. Ms. Merigeault states that "Mr. Simpson appears to have received the letter forwarding the formal papers for signature but has refused to execute the documents indicating to me that since Aventis terminated his employment, he sees no need to assist this company with administrative details." Merigeault Decl. ¶ 9. This explanation is insufficient. Section 409.03(d) of the MPEP explains what is required to prove a refusal by an inventor and states, in part:

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such

evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

In this case, applicants have not provided any documentary evidence required by the MPEP above such as a copy of the letter sent to Mr. Simpson. In addition, it is not clear if Mr. Simpson's conduct demonstrates a refusal. Applicants must investigate this matter further by attempting to contact Mr. Simpson and find out directly if he refuses to cooperate. The actions taken must be specified in a statement of facts signed by a person having firsthand knowledge of the details therein and submitted with the renewed petition.

Applicants also claim that co-inventor, Mark David Charles "cannot be located." Pet. ¶ 1. Ms. Merigeault succinctly states that "[t]he letter addressed to Mr. Charles has been returned by the Royal Mail in England with a stamp stating 'address unknown.' Aventis has been unable to locate a new address for Mr. Charles." Merigeault Decl. ¶ 7. This is insufficient to demonstrate that Mr. Charles cannot be located. Applicants' burden in proving that an inventor cannot be located is also explained in section 409.03(d) of the MPEP which states, in part:

Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

The statements by Ms. Merigeault do not sufficiently elaborate on the procedures applicants used to diligently locate Mr. Charles. There is no evidence submitted that applicants even attempted to contact him by telephone. Furthermore, applicants' have not provided any documentary evidence such as copies of letters, or postal receipts. Absent a sufficient showing that applicants have made a diligent effort to contact Mr. Charles, item (2) is not satisfied. Applicants' have not yet made such a showing.

Accordingly, since applicants failed to meet item (2), it is not appropriate to

accept this application under 37 CFR 1.47(a) at this time.

CONCLUSION

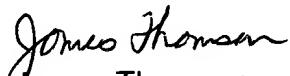
The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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